

Request For Reconsideration Of Decision On Petition

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Dated: **September 7, 2011**

Electronic Signature for Nicole R. Pruett: /Nicole R. Pruett/

Docket No.: 4967.012
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toshiaki Kawakami

Application No.: 09/901,359

Confirmation No.: 5346

Filed: July 9, 2001

Art Unit: 3751

For: SEAT SUPPORTING TABLE FOR A
BARBER OR BEAUTY CHAIR AND HAIR
WASHER WITH THE SEAT SUPPORTING
TABLE

Examiner: C. R. Eloshway

REQUEST FOR RECONSIDERATION OF DECISION ON PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please see **REMARKS** which begin on page 2 of this paper.

REMARKS

The present communication requests reconsideration of the Petition decision dated July 7, 2011.

The decision dated July 7, 2011 was based on the finding that there is no indication showing that the Examiner acted non-diligently with respect to the May 24, 2002 Information Disclosure Statement (IDS). In the following context, the decision dated July 7, 2011 states:

A review of the records shows that the examiner allowed the application on March 11, 2002 and three months later the IDS was filed on June 11, 2002 (with certificate of mailing showing the May 24, 2002 date). The issue fee was paid on June 24, 2002 (with certificate of mailing showing June 11, 2002 date). The IDS was submitted after the mailing of the Notice of Allowance of March 11, 2002 and prior to the payment of the Issue fee. During the time period between the filing date of the IDS of June 11, 2002 and issuance of the patent on August 22, 2002, the applicant did not make any inquiry with the Examiner regarding whether the IDS was approved or disapproved. Therefore, there is no indication showing the Examiner did not act diligently between the period that the IDS was filed and the issue fee was paid. *Patent application No. 09/901,359, Petition Decision dated July 7, 2011.*

The determination of the Office (if the Office maintains its position that the May 24, 2002 IDS was non-compliant) that there is no indication of lack of diligence of the Examiner is incorrect and must be vacated.

In fact (if the Office maintains its position that the May 24, 2002 IDS was non-compliant) the action of the Examiner during the pendency of the application with respect to the IDS dated May 24, 2002 ran completely afoul of the stipulated proper action of the Examiner .

Under MPEP provisions in effect at the time of the filing of the May 24, 2002 IDS, a non-complying IDS is to be responded to in a particular manner by the Examiner.

Specifically, the Examiner must notify an applicant of the non-compliance, provide reasons for non-consideration, and should draw a line through references not considered. MPEP § 609 (August 2001) states as follows:

C(1) Noncomplying Information Disclosure Statements

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501. If an information disclosure statement does not comply with the requirements based on the time of filing of the IDS as discussed in subsection III.B above, including the requirements for fees and/or statement under 37 CFR 1.97(e), the IDS will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use form paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed IDS, but the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the (37 CFR 1.97). The examiner should write "not considered" on an information disclosure statement where none of the information listed complies with the requirements, e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 or PTO/SB/08A and 08B form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. ***The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraphs 6.49 through 6.49.09.*** If the improper citation appears as part of another paper, e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered. If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and ***a line should be drawn through the citation to show that it has not been considered.*** However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner. (Emphasis added). MPEP § 609 (August 2001).

MPEP § 609 (August 2001) expressly details a variety of duties of an Examiner in response to a non-complying IDS. For example, an Examiner must provide notice to the Applicant regarding the non-compliance, detailing the reasons for the non-compliance. The Examiner should also indicate the citations not considered by drawing a line through the non-considered citation. The duty elements relative to notice and providing reasons for non-consideration are not even permissive duty elements. They are mandatory activity required by the Examiner in the case of a non-complying IDS

(“the Examiner **will** inform applicant that the information has not been considered and the reasons why by using form paragraph 6.49 through 6.49.09” (emphasis added)).

Notwithstanding the express mandatory duty of the Examiner to provide notice and reasons for non-consideration, the Examiner during the extensive (nearly three month) period between the time of the May 24, 2002 IDS and the time of issue provided no communication whatsoever to the applicant regarding the May 24, 2002 IDS. If the applicant had been notified of any deficiency regarding the May 24, 2002 IDS (as the Examiner was required to provide in the event of a non-complying IDS) the applicant would have had the opportunity to cure the non-compliance. While the Office’s decision references an asserted duty on the part of the applicant (“the applicant did not make any inquiry...”) the reference to an applicant duty is not understood. IDSs properly filed in the manner of the May 24, 2002 IDS are **required** to be considered (“[Properly filed IDSs] will be considered by the Examiner,” MPEP § 609 [August 2001]). If an IDS is found to be non-complying, the Examiner “will inform applicant,” MPEP § 609 (August 2001).

If the Office wishes to maintain its position that the IDS dated May 24, 2002 was non-conforming, the Office is respectfully requested to explain why it believes there is no lack of Examiner diligence on the record given the lack of notice regarding non-compliance, lack of reasons provided to the applicant and lack of strike through in the file record during the pendency of the application in view of the stipulated Examiner duty provisions regarding notice, reasons, and strike through which the applicant has highlighted .

The correct interpretation of the events of the application, as the applicant has maintained (see Request dated October 11, 2007, Response dated February 12, 2008 and Petition dated May 16, 2008) is that the lack of notice in the record indicates that the May 24, 2002 was properly regarded as complying. If the IDS was regarded as non-complying, the Examiner would have sent notice to the applicant under MPEP 609

(August 2001). Because the Examiner did not send such notice and reasons during the pendency the logical conclusion is that the IDS was regarded as complying.

The conclusion that the IDS was considered is reinforced not only by the lack of notice, reasons, and strike through in the application record but also positive indication of the IDS dated May 24, 2002 being considered in the file record. Namely the words "OK TO ENTER" on the application IDS paper. The Office has indicated elsewhere that indications of consideration other than examiner initials are acceptable as indicators that a reference has been considered. See OG Notice: September 11, 2007 ("under this deployment, Examiners will no longer initial each reference citation considered...").

Petitioner further herein incorporates by reference its concurrently filed Petition for Official Interpretation of September 7, 2011, its response of April 15, 2011, its Petition of May 16, 2008, its Response of February 12, 2008 and its Request of October 11, 2007.

Accordingly, in view of the above Petitioner petitions the Office to vacate its holding that the May 24, 2002 IDS was non-complying and that Examiner acted diligently with respect to the May 24, 2002 IDS. The grounds for the Denial being disproved, the Petitioner further petitions the Office to grant the Petition filed on May 16, 2008 and renewed April 15, 2011.

Dated: September 7, 2011

GB/nrp

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